Appl. No. 10/796,718
Response dated August 7, 2008
Reply to Office Action of May 22, 2008

PATENT

REMARKS

This paper is responsive to the Office Action mailed May 22, 2008. Claims 1-23, 25 and 26 are currently pending. Claims 1-23, 25 and 26 stand rejected. No amendments have been made to the claims, but a listing of the claims is provided for the convenience of the Examiner. Reconsideration of the claims in view of the following remarks is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-23 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2007/0005762 to *Knox* in view of U.S. Patent No. 5,878,230 issued to *Weber* and U.S. Patent Publication No. 2005/0012965 to *Bloomfield*. Claim 26 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Knox*, *Weber* and *Bloomfield* in view of U.S. Patent Publication No. 2004/0005498 to *Bargagli Damm*. Applicants respectfully traverse the rejection and submit that the cited references do not disclose all of the features of the claims.

Claim 1 recites:

In a web-based business information system having an internal e-mail facility, a method for facilitating and tracking e-mail communications between (i) an end user of the web-based business information system and (ii) an external contact that is not an end user of the web-based business information system, comprising:

sending an initial e-mail message from said internal e-mail facility to the external contact, wherein a domain of a REPLY-TO field of said initial e-mail message corresponds to a domain of said internal e-mail facility, and wherein a local part of said REPLY-TO field of said initial e-mail message comprises a tracking string encoding tracking information associated with said end user and said external contact with respect to said web-based business information system;

receiving a first reply e-mail message from said external contact replying to said initial e-mail message, said first reply e-mail message having a TO field including said tracking string; and

sending a modified version of said first reply e-mail message to a native e-mail address of the end user, said native e-mail address corresponding to a native e-mail system of the end user different than said internal e-mail facility and lying outside said web-based business information system, wherein a domain of a REPLY-TO field of said modified version of said first reply e-mail message corresponds to said domain of said internal e-mail facility, and wherein a local part of said REPLY-TO field comprises a first modified version of said tracking string.

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In other words, claim 1 requires "sending an initial e-mail message," "receiving a first reply e-mail message," "sending a modified version of said first reply e-mail message" all to be performed by the same device, i.e., the web-based business information system. However, none of the cited references, either alone or in combination, disclose this feature.

For example, *Knox* discloses a mail server 12 that sends an e-mail message to a mail client 26. (See *Knox* paragraph [0026]). The mail server 12 does not receive any reply e-mail messages nor does it send any modified versions of reply e-mail messages. *Weber* discloses a device which, after receiving an e-mail message from an original sender, can be configured to either (a) reply to the original sender or (b) reply to a third party. (See *Weber* col. 5, lines 4-22). *Weber* fails to disclose sending an initial e-mail message. Moreover, *Weber* does not disclose receiving replies to any of its own e-mail messages, and thus does not disclose "receiving a first reply e-mail message."

The most reasonable combination of *Knox* and *Weber* would result in the mail client 26 of *Knox* either (a) replying to the mail server 12/mail client 20 or (b) replying to a third party. In case (a), the mail server 12 would not send a modified version of any received e-mail messages. In case (b), the mail server 12 would neither receive any reply messages nor send a modified version of any received e-mail messages.

The Office Action states that the same device would be used to perform the aforementioned combination of features since *Weber* discloses "replying to an email where the reply is automatically filled with the address of the originator" (i.e., reply to original sender) and "sending the reply e-mail to a different address from which the email was originally sent" (i.e., reply to a third party). (See Office Action, page 4, last paragraph). However, Applicants respectfully disagree since the same device in *Weber* does not function to both (a) reply to the original sender and (b) reply to a third party. Rather, the device either replies to the original sender or replies to a third party. (See *Weber* col. 5, lines 4-22 and Figure 6 steps 82, 84, 86).

Claim 1 also recites "a domain of a REPLY-TO field of said initial e-mail message corresponds to a domain of said internal e-mail facility" and "a domain of a REPLY-TO field of said modified version of said first reply e-mail message corresponds to said domain of

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said internal e-mail facility." The Office Action states that both of these features are disclosed by *Weber*.

However, *Weber* does not disclose these features of claim 1. For example, *Weber* teaches configuring reply addresses for a <u>single</u> e-mail message, i.e., a sender can configure an outgoing email to be automatically replied back to the sender or be replied to a separate recipient list. (See *Weber* col. 4, lines 12-16 and figure 5). In contrast, claim 1 requires <u>two different</u> email messages to be configured - an initial e-mail message and a modified version of a first reply e-mail message. Moreover, *Weber* discloses configuring a message originating from the <u>same location,</u> i.e. from a sender device. In contrast, claim 1 requires configuring email messages originating from <u>different locations</u> - an initial email message (sent from the internal e-mail facility) and a modified version of a first reply e-mail message (received from an external contact).

Applicants respectfully submit that *Bloomfield* fails to cure the deficiencies of *Knox* and *Weber*. *Bloomfield* is directed to a facsimile to an e-mail communication system which, although teaching transaction codes being associated with a sender's fax interface device, provides no relevant teaching as to the aforementioned features.

Neither *Knox*, *Weber*, *Bloomfield* nor any of the other cited references, alone or in combination, disclose all of the features recited in independent claim 1. Specifically, *Knox*, *Weber* and *Bloomfield* do not disclose "sending an initial e-mail message from said internal e-mail facility to the external contact...; receiving a first reply e-mail message from said external contact replying to said initial e-mail message...; and sending a modified version of said first reply e-mail message to a native e-mail address of the end user." *Knox*, *Weber* and *Bloomfield* also do not disclose "a domain of a REPLY-TO field of said initial e-mail message corresponds to a domain of said internal e-mail facility, and... a domain of a REPLY-TO field of said modified version of said first reply e-mail message corresponds to said domain of said internal e-mail facility." For at least these reasons, claim 1 is allowable over the cited art.

Independent claims 15 and 20 recite features that are similar to the features recited in amended claim 1. As discussed above with reference to claim 1, the cited art does not

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teach these features. Thus, claims 15 and 20 are also allowable over the cited art for at least the same reasons as claim 1, as well as on their own merits.

Claims 2-14 are dependent on claim 1, claims 16-19 are dependent on claim 15, and claims 21-23, 25 and 26 are dependent on claim 20. As discussed above, claims 1, 15 and 20 are allowable over the cited art. Thus, claims 2-14, 16-19, 21-23, 25 and 26 are also patentable for the reasons discussed above with respect to claims 1, 15 and 20, as well as on their own merits.

In view of the foregoing, withdrawal of the rejection of claims 1-23, 25 and 26 under 35 U.S.C. 103(a) is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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